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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/193,833	11/17/1998	MARK GAINEY	003838.P001	2499

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EXAMINER

LE, DEBBIE M

ART UNIT PAPER NUMBER

2177

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/193,833

Applicant(s)

HORVATH ET AL.

Examiner

DEBBIE M LE

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

This is in response to the amendment filed on 8/8/02 (paper #15). Claims 1-13 are presented for examination.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a)

Claims 1, 4-7, 12-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Grasso et al (US Patent 5,892,909) in view of Angotti et al (6,182,059).

As to claim 1, Grasso discloses a system comprising:

receiving a message in an enterprise mail system, said a message from a human message sender (col. 7-8, lines 55-32);

categorizing said message by selecting a first category entry from a category database comprising a plurality of category entries, each said category entry containing information for handling particular incoming message (col. 4, lines 7-37, col. 7, lines 40-54, col. 8, lines 33-67, col. 9, lines 1-25, col. 14, lines 10-27);

a set of message recipients defined in said first category entry (col. 10, lines 48-67, col. 13, lines 28-67, col. 16, lines 1-32, col. 17, lines 36-59).

Grasso does not explicitly teach creating a response message using said first category entry, said response message including a response body defined in said first category entry. However, Angotti teaches creating a response message using said first category entry, said response message including a response body defined in said first category entry (fig. 2b, # 116a, col. 9, lines 14-31). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a response message body because it allow the system to provide an appropriate response to the inquiry of the customer.

As to claim 4, Grasso discloses a communication system comprising:

receiving a first message in an enterprise mail system, said a first message from a first human message sender (col. 7-8, lines 55-32);

storing said first message in a message database (col. 9, lines 26-61, col. 14, lines 10-27);

assigning a category entry from a category database to said first message, said category entry containing information for handling particular incoming message (col. 4, lines 7-37, col. 7, lines 40-54, col. 8, lines 33-67, col. 9, lines 1-25, col. 14, lines 10-27);

delivering said first message to a first enterprise mail system; providing a template response message to said first enterprise mail system user using information said category entry, said template response message including a set of message recipients defined in said category entry (col. 10, lines 48-67, col. 13, lines 28-67, col. 16, lines 1-32, col. 17, lines 36-59).

As to claim 5, Grasso discloses assigning a category entry from a category database to said first message is performed by a rule processor (col. 15, lines 18-47, col. 17, lines 10-17).

As to claim 6, Grasso discloses assigning a category entry from a category database to said first message is performed by said enterprise mail system user (col. 8, lines 57-67, col. 10, lines 48-67).

As to claim 7, Angotti discloses wherein providing a template response message further comprises providing a set of default message body sections for said template response message (col. 9, lines 14-32).

As to claim 12, Grasso discloses wherein said message database comprises a relational database (col. 14, lines 10-27, col. 32, lines 1-49).

As to claim 13, Grasso discloses wherein one of said recipients comprises said human message sender (col. 7-8, lines 55-32).

Claims 2, 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al (U.S Patent 5,892,909) and Angotti et al (6,182,059) and further in view of Gormley et al (U.S Patent 5,806,057).

As to claim 2, Grasso and Angotti do not explicitly teach recipient comprises a carbon copy recipient. However, Gormley 's invention discloses the computer is programmed to automatically generate lists of carbon copy recipients (fig. 8, 17, 19, 25, 24b, 29, 33a, # 501, col. 2, lines 9-12, col. 15, lines 30-38, col. 18, lines 1-67, col. 19, lines 1-11). It would have been obvious to one of ordinary skill in the art the time the invention was made to utilize a carbon copy in an e-mail system in order to provide better communication among users in a network.

As to claims 8-11, Grasso and Angotti do not explicitly teach one set of default message body sections comprising: a salutation, a body header, a closing, and a footer. However, Gormley's does teach those features (fig. 8, 17, 19, 25, 24b, 28, 33, # 486, 467, 34a, col. 16, lines 64-65, col. 17, lines 56-67, col. 25& 26). One of ordinary skill in the art is motivated to modify Grasso and Angotti according to Gormley to generate a response with a predefined form in order to speed up the response time.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al (U.S Patent 5,892,909) and Angotti et al (6,182,059), further in view of Linstead et al (U.S Patent 5,548,753).

As to claim 3, Grasso and Angotti do not explicitly teach recipient comprises a blind carbon copy recipient. However, Linstead's invention discloses a blind carbon copy recipient in the e-mail system (col. 2, lines 25-36, col. 3, lines 31-35, col. 7, lines

51-54). It would have been obvious to one of ordinary skill in the art the time the invention was made to utilize a blind carbon copy in an e-mail system in order to provide better communication among users in a network.

### ***Response to Arguments***

Applicant's arguments filed on 8/8/02 (paper #15) have been fully considered but they are not persuasive.

Applicants' argue that neither the Grasso reference nor the Angotti reference teach a system that uses a category database to categorize incoming message.

In response, the examiner respectfully disagrees. Grass et al ('900) teaches in column 8, lines 20-26 that "search service providers uses human editors and digital librarians to organize and structure general information into categories and meaningful summaries. For a corporation to depend upon meaningful categories and keywords would require dedicated internal editors and librarians or a general community of authors following rigorously enforced cataloging and categories standards." Even if Grass does not clearly teach uses a category database to categorize incoming message, then Angotti et al ('059) teaches uses a category database to categorize incoming message at column 2, lines 59-62 that " there is a need in the art for a system which overcomes the shortcomings of the prior art by receiving electronic messages, classifying and categorizing the message." At column 3, lines 30-36 that "the present invention includes a method for automatically interpreting an electronic message including the steps of (a) receiving the electronic message from a source; (b)

interpreting the electronic message using a rule base and case base knowledge engine; and (c) **retrieving one or more predetermined** responses corresponding to the interpretation of the electronic message **from a repository for automatic delivery to the source**". And at column 9, lines 14-19, Angotti teaches that "When the automatic message reader 30 has classified the E-mail message 11 as being of the "automatic" type (step 114a), one or more **predetermined responses (or prepared responses) are retrieve from a repository (or database)**. From the above passages, it is clear that using a category database to categorize incoming message. Thus, the teachings of Angotti "when the automatic message reader 30 has classified the E-mail message 11 as being of the "automatic" type (step 114a), one or more predetermined responses (or prepared responses) **are retrieve from a repository (or database)**" does indeed anticipate the claimed uses a category database to categorize incoming message

### ***Conclusion***

Claims 1-13 are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose phone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M LE whose telephone number is 703-308-6049. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN BREENE can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-7960.

Debbie Le

Oct. 22, 2002.

  
  
GRETA ROBINSON  
PRIMARY EXAMINER